

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK R. KINCS,
REYNALDO G. CRUZ,
and
ROBERT K. JOHNSON

Appeal No. 1999-0140
Application No. 08/622,953

ON BRIEF

Before KIMLIN, GARRIS, and OWENS, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 1, 3, 5, 6, 8-14, 16, 19-34, 36 and 40-42 as amended subsequent to the final rejection. These are all of the claims pending in the application.

The subject matter on appeal relates to a high elaidic hard butter having been elaidinized from cis-configured oleic

Appeal No. 1999-0140
Application No. 08/622,953

acid to have at least about 65 weight percent trans-configured
elaidic acid wherein the elaidinized hard butter exhibits a
solid fat

index profile having a steep slope approximating that of lauric fat hydrogenated palm kernel oil having a melting point of about 92°F and wherein said elaidinized hard butter has a fully saturated fat content of not greater than about 10 percent by weight. The appealed subject matter also relates to an elaidinized hard fat which corresponds to the aforementioned elaidinized hard butter as well as to a confectionary coating composition which includes the hard butter. The subject matter on appeal further relates to a process for making an elaidinized hard butter having the aforementioned characteristics comprising the steps of providing a vegetable oil having a high oleic content of at least about 75 weight percent oleic acid and hydrogenating the high oleic acid vegetable oil in the presence of a deadened catalyst in order to elaidinize the oil to the elaidinized hard butter. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. A high elaidic hard butter, comprising: an elaidinized vegetable oil having an initial oleic acid content of at least about 75 weight percent, based upon the total weight of the hard butter, said hard butter having been elaidinized from cis-configured oleic acid to have at least about 65 weight percent trans-configured elaidic acid, based upon the total weight of the hard

Appeal No. 1999-0140
Application No. 08/622,953

butter, said elaidinized hard butter has a melting point between about 90° F. and human body temperature and exhibits a solid fat index (SFI) profile having a steep slope approximating that of lauric fat hydrogenated palm kernel oil having a melting point of about 92° F., said elaidinized hard butter also having a fully saturated fat content of not greater than about 10% by weight, based upon the total weight of the elaidinized hard butter, and said elaidinized hard butter has an Iodine Value of at least about 75.

The references relied upon by the examiner as evidence of obviousness are:

Hasman 1979	4,134,905	Jan. 16,
Fick (Fick '192) 1986	4,627,192	Dec. 9,
Fick (Fick '402) 1988	4,743,402	May 10,

All of the appealed claims are rejected under 35 U.S.C. § 103 as being unpatentable over Hasman in view of Fick '192 or Fick '402.

These rejections cannot be sustained.

According to the examiner, "[i]t would be [sic, would have been] obvious to one of ordinary skill in the art to hydrogenate the fat of Fick by the process of Hasman in order to prepare a high elaidic hard butter" (answer, page 4). Even assuming this contention by the examiner is correct, the

rejection nevertheless could not be sustained. This is because the process resulting from the examiner's proposed combination of Hasman and Fick would not correspond to the appellants' claimed process and would not yield a butter (or fat) of the type defined in the appealed product claims.

Specifically, Hasman's product and process differ in a number of respects from the product and process claimed by the appellants. For example, patentee's product has no more than about 45 percent trans-oleic acid (i.e., trans-configured elaidic acid) content (e.g., see lines 49-50 in column 1 of the Hasman patent) rather than at least about 65 weight percent as required by the appealed product claims.

Additionally, Hasman contains no teaching or suggestion that his product has a fully saturated fat content of not greater than about 10 percent by weight as required by the product claims on appeal. On the contrary, product runs 1 and 2 disclosed by Hasman resulted in a fully saturated fat content of 26.6 weight percent and 24.7 weight percent as explained by the appellants on pages 15-16 of the brief and page 5 of the

Appeal No. 1999-0140
Application No. 08/622,953

reply brief.¹ Moreover, for the reasons explained by the appellants (e.g., see pages 2-4 of the reply brief), Hasman's product cannot be regarded as having a solid fat index profile of the type defined by the appealed product claims. In response to the appellants' arguments concerning the above-discussed claim distinctions, the examiner expresses her

¹Significantly, the examiner has not disagreed with the appellants on this matter.

position in the paragraph bridging pages 6 and 7 of the answer as follows:

It is not the examiner[']s position that the properties of the claims are identically disclosed in Hasman. Rather it is the examiner's position that the hydrogenation process of Hasman on the oil of Fick would have been obvious to one of skill in the fat art. The properties of the fats of the claims would naturally result from the process of Hasman on the fat of Fick.

We cannot agree for a number of reasons.

In the first place, we agree with the appellants that their claimed process differs from the process of Hasman. For example, Hasman does not employ a deadened catalyst as expressly required by process claim 27 on appeal. With respect to this issue, the examiner points out that Hasman refers to a sulfur poisoned nickel catalyst (i.e., a deadened catalyst) at lines 15-18 in column 1. This disclosure, however, relates to a prior art technique for elaidinizing glyceride oil and is completely unrelated to patentee's two-step hydrogenation process which clearly employs active catalysts.²

²For purposes of clarification, we emphasize that the examiner does not contend that it would have been obvious to use a deadened catalyst in the process of Hasman, and indeed no basis exists for such a contention in the absence of

Appeal No. 1999-0140
Application No. 08/622,953

impermissible hindsight.

The examiner's above-quoted reasoning is also deficient because it presumes that an artisan would have combined the Hasman and Fick teachings in such a manner as to necessarily result in a butter or fat of the type here-claimed. This is incorrect. Neither Hasman nor the Fick references contain any teaching or suggestion of making a butter having the characteristics of the appellants' claimed butter (or fat). The only disclosure in these references concerning butter characteristics constitutes Hasman's teaching of producing a butter having characteristics which differ in a number of respects from those here-claimed as previously discussed.

Thus, it is clear that, in combining the applied references, the artisan would have followed the teachings of Hasman and therefore would have produced a butter having the characteristics of patentee's butter rather than those claimed by the appellants.

Appeal No. 1999-0140
Application No. 08/622,953

In light of the foregoing, we cannot sustain either of
the Section 103 rejections before us on this appeal.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

BRG:hh

Appeal No. 1999-0140
Application No. 08/622,953

COOK, ALEX, MCFARRON, MANZO,
CUMMINGS & MEHLER, LTD.,
200 WEST ADAMS STREET
SUITE 2850
CHICAGO, IL 60606